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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/342,971	06/29/1999	TONY F. RODRIGUEZ	4830-53055/W	7370

23735 7590 06/21/2002

DIGIMARC CORPORATION
19801 SW 72ND AVENUE
SUITE 100
TUALATIN, OR 97062

EXAMINER

LASTRA, DANIEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/342,971

Applicant(s)

RODRIGUEZ ET AL.

Examiner

DANIEL LASTRA

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Claims 1-5 have been examined.

Drawings

2. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rathus et al (U.S. 5,932,863) in view of Rhoads (U.S. 6,285,776).

As per claim 1, Rathus et al teach:

“steganographically encoding a print advertisement to hide plural-bit data therein”
(see column 5, lines 21-27 and column 6, lines 13-16);

“using at least a part of the extracted plural-bit data to direct an Internet web browser to a web site that provides consumer information related to a product or service promoted by the print advertisement” (see column 7, lines 61-67 – column 8, lines 1-23). Rathus et al do not explicitly mention an Internet web browser. However, the Rathus et al system teaches that the communication of certain information, such as

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pricing information or scheduling information, from the server to the user display unit, would easily be transmitted via an inexpensive telephone/modem link (see column 10, lines 40-48). Also, Rathus et al teach that one of the services provided to the customer upon processing the print advertisement to extract the embedded data, is a computer "chat" link. The Internet, to one ordinary skilled in the art, for some time now is recognized as a vehicle in which information is shared from computer to computer. A typical example would be a chat room site where customers communicate or chat with each other. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Rathus et al system could provide a computer "chat" link by a telephone/modem link and that it would use a web browser to connect to the Internet and provide consumer information related to a product or service. This feature would provide users with a way to obtain product information no matter where they are located.

Rathus et al fail to teach "acquiring visible light scan data from the print advertisement and processing same to extract the plural-bit data therefrom". However, Rhoads teaches a method of using a visible light scanner to recognize a security document by referencing to a steganographic digital watermark encoded in the document (see claim 3). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that steganographic data is digital data in hidden form and that the invisible bar code described in Rathus et al (see column 6, lines 10-16) would be read by the visible light scanner taught in Rhoads.

As per claim 2, Rathus et al teach:

"steganographically encoding a first print advertisement with first data" (see column 5, lines 22-27 and column 6, lines 10-35) ;

"steganographically encoding a second print advertisement with second data" (see column 5, lines 22-27 and column 6, lines 10-35);

Rathus et al does not expressly teach, "tallying the number of decoded first and second data, respectively, to determine consumer response to the advertisements". However, lines 31-35 of column 6 teach of an identification code generated by a recognition unit that allows the advertiser to identify the potential customer. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the advertiser would recognize the decoded data and that it would be used to better target advertisement to customers.

Rathus et al fail to teach, "decoding the first and second data when consumers present the first and second advertisements to visible light optical sensor". However, Rhoads teaches a method of using a visible light scanner to recognize a security document by referencing to a steganographic digital watermark encoded in the document (see claim 3). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that steganographic systems conveys digital data in hidden form and that the invisible bar code described in Rathus et al (see column 6, lines 10-16) would be read by the visible light scanner taught in Rhoads.

As per claim 4, Rathus et al teach:

"steganographically encoding a travel photograph to hide plural-bit data therein" (see column 5, lines 21-27, column 6, lines 13-16 and column 7, lines 61-67 – column 8, lines 1-23);

"using at least part of the extracted plural-bit data to direct an Internet web browser to a web site that provides travel information useful to a consumer who wishes to visit the location depicted in the photograph" (see column 7, lines 61-67 – column 8, lines 1-23). Rathus et al do not explicitly mention an Internet web browser. However, the Rathus et al system teaches that the communication of certain information, such as pricing information or scheduling information, from the server to the user display unit, would easily be transmitted via an inexpensive telephone/modem link (see column 10, lines 40-48). Also, Rathus et al teach that one of the services provided to the customer upon processing the print advertisement to extract the embedded data, is a computer "chat" link. The Internet, to one ordinary skilled in the art, for some time now is recognized as a vehicle in which information is shared from computer to computer. A typical example would be a chat room site where customers communicate or chat with each other. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Rathus et al system would provide a computer "chat" link by a telephone/modem link and that would use a web browser to connect to the Internet and provide travel information useful to a consumer. This feature would provide users with a method to obtain product information no matter where they are located.

Rathus et al fail to teach, "acquiring visible light scan data from the travel photograph and processing same to extract the plural-bit data therefrom". However, Rhoads teaches a method of using a visible light scanner to recognize a security document by referencing to a steganographic digital watermark encoded in the document (see claim 3). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that steganographic systems convey digital data in hidden form and the invisible bar code described in Rathus et al (see column 6, lines 10-16) would be read by the visible light scanner taught in Rhoads.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski (U.S. 5,905,246).

As per claim 3, Fajkowski teaches:

"presenting an object within the field of view of a visible light optical sensor device, the object being selected from the list consisting of a retail product, or packaging for a retail product" (see column 15, lines 11-41 and column 8, lines 37-40);

"acquiring optical data corresponding to the object" (see column 15, lines 20-28);

"decoding plural-bit digital data from the optical data" (see column 15, lines 20-28);

"submitting at least some of said decoded data to a remote computer" (see column 22, lines 10-67); and

Fajkowski does not expressly teach, "determining at the remote computer whether a prize should be awarded in response to submission of said decoded data". However, as columns 22-24 teach, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Fajkowski provides incentives to

customers for buying at their store. Awarding prizes would be equivalent to awarding incentives and would not patentably distinguish the claimed invention from the prior art.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski (U.S. 5,905,246) in view of Rathus et al (U.S. 5,932,863).

As per claim 5, Rathus et al teach the method of claim 3 in which the optical data includes steganographically encoded information (see column 6, lines 10-16). The Applicant recognizes (in the specification on page 4) that steganographic data conveys data in hidden form. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the invisible bar code described in Rathus et al on column 6, lines 10-16 would also convey steganographically encoded information.

Conclusion

Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

The Applicant argues that the only form of invisible bar code known to the applicant is a bar code printed in an ultraviolet-responsive ink. The Applicant argues that the invisible bar code contemplated by Rathus cannot be read by the visible light scanner taught in Rhoads because such marking is not manifested except with ultraviolet illumination.

The Examiner answers that Rhoads teaches in claim 3, the recognizing of a security document by reference to a steganographic digital watermark encoded in a digital image and detectable by visible light scanning the document. Also Rhoads teaches in column 13, lines 1-4 that the watermark may be conceptualized as an invisible bar code employed in a purchase transaction. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that ultraviolet illumination is not the only method use to detect invisible bar codes as Rhoads teaches the detection of invisible bar codes using a visible light scanner. Rathus would use the visible light scanner taught by Rhoads to detect and decode invisible bar codes encoded in documents.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 7:30-3:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

D.L.

Daniel Lastra

June 14, 2002


MELANIE A. KEMPER
PRIMARY EXAMINER